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A-S

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/529,717 08/22/00 KIMURA

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EXAMINER
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IM22/0305

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SERGENT, R	
ART UNIT	PAPER NUMBER

1711

DATE MAILED:

03/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/529,717

Applicant(s)  
Kimura et al.

Examiner  
Rabon Sargent

Group Art Unit  
1711



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-6 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-6 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1711

1. Claims 2, 3, 5, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 2 and 5, the use of "may" renders the claims indefinite, because it is unclear to what extent the language denoted by "may" is a definitive limitation.

Within claims 3 and 6, the amide species should be listed in the alternative.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 46-27874 in view of Ishii et al. ('744) or JP 6-93070 or JP 57-108154.

Art Unit: 1711

The primary reference discloses the use of a long chain amide compound, corresponding to that of applicants' formula I, which is used as a polyurethane discoloration stabilizer. See abstract.

4. The primary reference is silent regarding the use of hindered phenol antioxidants; however, hindered phenols were known polyurethane antioxidants at the time of invention. This position is supported by the teachings of the secondary references.

5. Since it has been held that it is *prima facie* obvious to utilize known ingredients for their known functions (In re Linder, 173 USPQ 356. In re Dial et al., 140 USPQ 244.) and to combine individual components, each of which is known to be useful for the same purpose, to form a composition which is to be used for the very same purpose (In re Kerkhoven, 205 USPQ 1069.), the position is taken that it would have been obvious to utilize both an amide stabilizer and a hindered phenol stabilizer within a polyurethane, so as to arrive at the instant invention.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sergent/om  
January 30, 2001